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09/630,604

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August 1, 2000

First Named Inventor

Masood Garahi

Art Unit

3714

Examiner Name

Scott E. Jones

Attorney Docket Number

ODS-23

ENCLOSURES (Check all that apply)

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- ☐ Fee Attached
- ☐ Amendment/Reply
- ☐ After Final
- ☐ Affidavits/declaration(s)
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PATENTS

Attorney Docket No. ODS-23

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Applicants/ : Masood Garahi et al.
Appellants

Application No. : 09/630,604 Confirmation No. : 8445

Filed : August 1, 2000

For : INTERACTIVE WAGERING SYSTEM WITH
WIRELESS WAGERING CAPABILITIES

Art Unit : 3714

Examiner : Scott E. Jones

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April 12, 2007

REPLY BRIEF

Sir:

Pursuant to 37 C.F.R. § 1.193(b), applicants/
appellants are filing this Reply Brief in reply to the
Examiner's Answer dated February 12, 2007 (hereinafter "the
Examiner's Answer"), and in support of their appeal from the
final rejection of claims 1-86, 89-133, and 135-144 in the
Office Action dated July 8, 2004. Applicants/Appellants
previously filed a Notice of Appeal on December 8, 2004 and an
Appeal Brief on June 7, 2005 (hereinafter "Appeal Brief") in
connection with this case.

REMARKS

I. Introduction

Applicants/Appellants maintain the position that claims 1-86, 89-133, and 135-144 of the present application are patentable in view of Brenner U.S. Patent 6,004,211 ("Brenner"), Lappington U.S. Patent 5,734,413 ("Lappington"), and LaDue U.S. Patent 5,999,808 ("LaDue"). Applicants/Appellants submit that the Examiner's Answer is insufficient as a matter of law to uphold the 35 U.S.C. § 103(a) rejections of claims 1-86, 89-133, and 135-144 for at least the reasons set forth in applicants/appellants' Appeal Brief. Applicants/Appellants have filed this Reply Brief to address comments in the February 12, 2007 Examiner's Answer and to further demonstrate the patentability of applicants/appellants' claims 1-86, 89-133, and 135-144.

II. Summary of the Examiner's Answer

The Examiner's Answer maintains the § 103(a) rejections of claims 1-86, 89-133, and 135-144 from the July 8, 2004 Office Action and restates the same grounds of rejection from that Office Action.

The Examiner's Answer also provides comments in response to arguments presented in applicants/appellants' Appeal Brief and appears to raise a new motivation argument for combining Brenner and Lappington.

III. Summary of the Applicants/Appellants' Reply

Applicants/Appellants' Appeal Brief fully addresses the grounds of rejection stated in the July 4, 2004 Office Action.

This Reply Brief will fully address the Examiner's comments on applicants/appellants' arguments in the Appeal Brief and the Examiner's new motivation argument for combining Brenner and Lappington.

Applicants/Appellants submit that the Board should find the rejections of claims 1-86, 89-133, and 135-144 under 35 U.S.C. § 103(a) to be in error and should reverse the Examiner.

IV. Argument of Claims 1-86 and 91-133

Applicants/Appellants submit that the Examiner's Answer is insufficient to uphold the 35 U.S.C. § 103(a) rejections of claims 1-86 and 91-133 for at least the reason that the Examiner has still failed to provide a proper motivation or objective teaching for combining Brenner and Lappington in the manner suggested by the Examiner.

It is well-settled that, in order to establish a *prima facie* case of obviousness, there must be some objective teaching in the references themselves or in knowledge generally available to one of ordinary skill in the art to combine the references in the manner that renders the claimed invention obvious. More significantly,

[i]t is difficult but necessary that the decisionmaker forget what he or she has been taught . . . about the claimed invention and cast the mind back to the time the invention was made (often as here many years), to occupy the mind of one skilled in the art who is presented only with the references, and who is normally guided by the then-accepted wisdom in the art.

W.L. Gore & Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 220 USPQ 303, 313 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984) (emphasis added).

Applicants/Appellants submit that the Examiner has failed to fulfill this requirement because the Examiner's proffered motivation includes knowledge that is derived only from applicants/appellants' own disclosure and therefore violates the requirement of objective evidence. *In re McLaughlin* 443 F.2d 1392, 1395, 170 USPQ 209, 212 (CCPA 1971). Specifically, the applicants/appellants' own disclosure is the only source of motivation for combining Lappington's handheld device with Brenner and modifying Lappington's handheld device

to include "on-screen options ... that allow the user to create a wager for a given race to be run" as specified in applicants/appellants' independent claims 1, 44, and 91.

A. The Examiner's Comments in the Examiner's Answer Fail to Address the Substance of Applicants/Appellants' Arguments

In the Examiner's Answer, the Examiner attempts to avoid the substance of each of applicants/appellants' arguments by stating that applicants/appellants rely "on the erroneous assumption that the combination of Brenner and Lappington would require" transferring wagering screens from the in-home user equipment to the wireless portable computing device" (Examiner's Answer, §§ 10.A.1.a (Handheld...), 10.A.1.a (The Examiner...), 10.A.1.b, and 10.A.1.c; See also § 10.A.1). Applicants/Appellants' arguments, however, do not rely on this assumption. Instead, applicants/appellants' reference to Brenner's screens in the Appeal Brief is directed to the content of the screens as will be explained in greater detail below. Applicants/appellants agree with the Examiner that the claims require on-screen options, not screens, and that text could read on applicants/appellants claimed on-screen options.

Applicants/Appellants believe the Examiner concedes that neither Brenner nor Lappington discloses "providing a user at the wireless portable computing device with on-screen options ... that allow the user to create a wager for a given race to be run" as required by applicants/appellants' claims. Brenner discloses providing options that allow a user to create a wager, but not on a wireless portable computing device in accordance with the claims. Rather, Brenner discloses providing these options in easy-to-read menu screens on, for example, a television monitor (see Brenner, column 7, lines 21-26).

Accordingly, Brenner's system, not Lappington's system, discloses such on-screen options, but not as required by applicants/appellants' claims. Therefore, if Lappington's handheld were combined with Brenner with no other modification,

the combination would fail to show or suggest providing a user at a wireless portable computing device with on-screen options that allow a user to create a wager.

In view of the foregoing, in order for the Examiner to establish a *prima facie* case of obviousness, there must be some objective teaching to provide on-screen options that allow the user to create a wager for a race on Lappington's handheld device. As discussed above, Brenner teaches providing such on-screen options as part of its graphical user interface. The Examiner, however, in the July 8, 2004 Office Action, failed to provide the requisite motivation for one of skill in the art to provide Brenner's on-screen options on Lappington's handheld device. Applicants/Appellants' Appeal Brief provides detailed arguments in support of this position.

Applicants/Appellants submit that the foregoing remarks clarify the arguments presented in the June 7, 2005 Appeal Brief. Moreover, applicants/appellants will briefly summarize the arguments presented in the Appeal Brief below using the "on-screen options" language to ensure there is no further misunderstanding.

Applicants/Appellants' first argument is that Brenner teaches away from providing its on-screen options on Lappington's handheld device for two reasons. The first reason is that Brenner's on-screen options include graphical elements (See, e.g., Fig. 35). Because graphics are not supported by Lappington's handheld device, Brenner teaches away from providing its on-screen options on Lappington's handheld device (See Appeal Brief, § IX.A.1.a). The second reason is that Brenner teaches away from using Lappington's limited display (i.e., "a 4-line by 16 character display") to display its on-screen options (See Appeal Brief, § IX.A.1.b).

Further, as set forth in § IX.A.2.a of the Appeal Brief, in the final Office Action the Examiner failed to provide any objective evidence of a motivation "to display

information/wager choices on the PDA to allow the race to be displayed on a separate display continuously" (July 8, 2004 Office Action, p. 3). Applicants/Appellants maintain the argument set forth in the Appeal Brief. Applicants/Appellants' argument, contrary to the Examiner's position in the Examiner's Answer, does not rely on the transfer of Brenner's "screens" to Lappington's handheld device.

Further, as set forth in § IX.A.2.b of the Appeal Brief, viewing multiple concurrent events without losing scores is not a proper motivation for providing the claimed on-screen options on Lappington's handheld device. Applicants/Appellants again maintain the argument set forth in the Appeal Brief. The substance of applicants/appellants' argument, contrary to the Examiner's position in the Examiner's Answer, does not rely on the transfer of Brenner's "screens" to Lappington's handheld device.

Finally, as set forth in § IX.A.2.c of the Appeal Brief, even if viewing multiple concurrent events without losing scores is a proper motivation, it would not lead one skilled in the art to achieve applicants/appellants' claimed invention. Rather, applicants/appellants submit that one of skill in the art would modify the operation of Brenner's existing on-screen interface, which is displayed, for example, on a television monitor. It would not be reasonable for one of skill in the art to act on this alleged motivation to apply Brenner's on-screen options to a handheld device to achieve applicants/appellants' claimed invention.

B. The Examiner's New Alleged Motivation for
Combining Brenner and Lappington Is
Insufficient as a Matter of Law

The Examiner, in the response to argument section of the Examiner's Answer, appears to provide a new alleged motivation for combining Brenner and Lappington to achieve applicants/appellants' claimed invention. Applicants/

appellants submit that the new motivation is insufficient as a matter of law.

Lappington refers to the data it transmits to its handheld devices as scripts. Lappington describes several different types of scripts including live event scripts. Lappington states that "[l]ive event scripts are to be used with live events, for example, sports, news and talk shows" (column 10, lines 36-37). Based on this disclosure of Lappington, the Examiner's provides the following new alleged motivation in the Examiner's Answer:

Lappington teaches of an interactive system that ... presents the interactive program (on display 398) and allows the viewer to participate in an interactive program. The interactive program may be a live event, such as a sporting event-horse racing. Therefore, the Examiner maintains the combination of Brenner and Lappington render [sic] the claimed invention obvious. (Examiner Answer, § 10.A.1)

Applicants/Appellants would like to first point out that nowhere does Lappington specifically teach using its handheld device with horse racing. Second, Lappington is not directed to wagering of any kind. Therefore, applicants/appellants submit that the combination of Brenner and Lappington with its live event scripts still fails to show or suggest providing on-screen options that allow a user to create a wager for a race on Lappington's handheld device.

The claimed on-screen options are not disclosed in Lappington and the Examiner has failed to provide any motivation for providing Brenner's existing on-screen options on Lappington's handheld device. In order to sustain an obviousness rejection based upon a combination of any two or more prior art references, the prior art must properly suggest the desirability of combining the particular elements. The mere fact that references can be combined or modified does not render the resultant combination obvious, unless the prior art also

suggests the desirability of the combination. In re Mills, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).

For at least the foregoing reasons and the reasons set forth in the Appeal Brief, applicants/appellants respectfully submit that the Board should find the rejections of claims 1-86 and 91-133 under 35 U.S.C. § 103(a) to be in error and should reverse the Examiner.

V. Argument of Claims 142-144

Applicants/Appellants' independent claims 142-144 include features that are similar to the features claimed in independent claims 1, 44, and 91. The Examiner in the Examiners' Answer relies on the same arguments presented with regard to applicants/appellants' independent claims 1, 44, and 91. Accordingly, applicants/appellants submit that the Board should find the rejection of claims 142-144 under 35 U.S.C. § 103(a) to be in error and should reverse the Examiner for at least the reasons provided above in Section IV.

VI. Argument of Claims 89, 90, and 135-141

Applicants/Appellants submit that the Examiner's Answer is insufficient to uphold the 35 U.S.C. § 103(a) rejection of claims 89, 90, and 134-141 in view of Brenner and Ladue for at least the reason that the combination of Brenner and LaDue fails to show or suggest "allowing the user to transmit the wager from the wireless user equipment to a communications network via communications equipment at a racetrack that communicates wirelessly with the wireless user equipment" (emphasis added) as required by independent claims 89, 90, and 135.

In the Examiner's Answer, the Examiner discusses how Brenner teaches delivering information using broadcast and satellite systems and that transactions can be "accomplished through any suitable, conventional, communication circuitry"

(Examiner's Answer, § 10.C). The Examiner also discusses how LaDue "can be integrated into existing wireless networks without requiring additional network build-outs" (Examiner's Answer, § 10.C). The Examiner then concludes that "[w]ith this information Examiner believes that there are no gaps in features taught by Brenner in view of LaDue to meet Applicant's claims and the rejection was proper" (Examiner's Answer, § 10.C). Applicants/Appellants respectfully disagree.

Applicants/Appellants submit that this information and the information in the July 8, 2004 Office Action fail to fill the gap of "communications equipment at a racetrack that communicates wirelessly with the wireless user equipment." Neither Brenner nor LaDue teach such communications equipment. Further, the Examiner has failed to provide any objective motivation or teaching to provide such equipment at a racetrack.

For at least the foregoing reasons and the reasons set forth in the June 7, 2005 Appeal Brief, applicants/appellants respectfully submit that the Board should find the rejection of claims 89, 90, and 135-141 under 35 U.S.C. § 103(a) to be in error and should reverse the Examiner.

VII. Conclusion

For at least the reasons set forth above, applicants/appellants respectfully submit that claims 1-86,

89-133, and 135-144 are in condition for allowance. The Examiner's rejections of these claims should be reversed.

Respectfully submitted,



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